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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,796	01/04/2001	Krystyna Roslan-Szulc	PK1201T1	3261
7590	03/11/2004			
Horst M. Kasper 13 Forest Drive Warren, NJ 07059			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER 23
DATE MAILED: 03/11/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**BEST AVAILABLE COPY**

## Office Action Summary

Application No.

09/754,796

Applicant(s)

ROSLAN-SZULC, KRYSTYNA

Examiner

John J. Wilson

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-16 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eisner et al (4728290) in view of Stearns (6095811) and Curry ((1742061). Eisner shows an elastic protective covering 10 made of a thermoshrinkable material, column 9, lines 15-25. The specific tolerance used is an obvious matter of choice in the degree of a known parameter to one of ordinary skill in the art looking to find the best match for the intended instrument. Further the tolerance that the sleeve may make with an inferentially claimed instrument is an obvious matter of choice in the use of the sleeve with an inferentially claimed element. Eisner does not show an elliptical shape. Stearns shows a non-round cross section, see Fig. 2. It would be obvious to one of ordinary skill in the art to modify Eisner to include a non-round shape as shown by Stearns in order to better fit the intended instrument. The specific shape used is an obvious matter of choice in shape to the skilled artisan looking to best match the shape of the intended instrument. Further, the shape before application is a pre step and is not given patentable weight. Eisner shows a tab, or wing, 18 located at the open end to assist in removing the cover, however, does not show hinged ends. Curry shows two hinged

Art Unit: 3732

ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to make use of known ways of attaching wings to protective covers in the art.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Cooper et al ( ) and Curry (1742061). Fife shows a heat shrinkable protective covering 71, column 3, lines 49-51, having a wing, see the "proximal pull tab" in Fig. 10. Fife does not show an end in the shape of a semi-sphere. Cooper shows a rounded end, Fig. 2a. It would be obvious to one of ordinary skill in the art to modify Fife to include a rounded end as shown by Cooper in order to make use of well known shapes for protective covers. The above combination does not show two hinged wings. Curry shows two hinged ends 9, 10, see Fig. 5. It would be further obvious to one of ordinary skill in the art to modify the above combination to include two hinged ends as shown by Curry in order to better cover the instrument. As to claim 3, Fife shows a flattened sheet in Fig. 4. The process of making is an obvious matter of choice in process steps to the skilled artisan. The specific shape of the cover is an obvious matter of choice in a non-critical shape of a known structure to one of ordinary skill in the art.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife. Fife shows employing a tubular protective covering 71 having a wing, see the "proximal pull tab" in Fig. 10, placing a dental instrument 112 into the cover and removing by

Art Unit: 3732

pulling on the tab. To pull the tab in the direction of the body of the cover to remove would be an obvious matter of choice in the direction of pulling to one of ordinary skill in the art looking to remove a covering. The number of wings used is an obvious matter of choice in the number of a known element used to the skilled artisan.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fife as applied to claim 6 above, and further in view of Eisner et al. Fife does not show rolling the cover when removing. Eisner teaches turning the cover inside out when removing by pulling on wing 18, column 9, lines 43-55. It would be obvious to one of ordinary skill in the art to modify Fife to include turning the cover inside out as shown by Eisner in order to protect the user from contamination. To roll the cover is an obvious matter of choice in the manner of turning the cover inside out to one of ordinary skill in the art.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) as applied to claim 8 above and further in view of Holt et al (5070597). Fife teaches heating to shrink fit the cover, however, does not show using a flame. Holt teaches that it is known to heat by use of a flame, column 14, lines 30-33. It would be obvious to one of ordinary skill in the art to modify Fife to include using a flame to heat as shown by Holt in order to make use of known ways of heat shrinking covers. To turn the instrument while heating is an obvious step to one of ordinary skill in the art in order to evenly shrink the cover. As to claim 11, the distance from the flame is an

Art Unit: 3732

obvious matter of choice in the degree of a known parameter to the skilled artisan wishing to apply the desired heat.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fife (5480302) in view of Holt et al (5070597) as applied to claim 10 above and further in view of Eisner et al (4728290). The above combination does not show cutting a hole for the bur. Eisner teaches cutting a hole for the bur, column 9, lines 15-18. It would be obvious to one of ordinary skill in the art to modify the above combination to include cutting a hole as shown by Eisner in order to be able to use the instrument. As to claim 13, Eisner also teaches using water spray. It would be obvious to also cut a hole for such spray because it is the only logical way to use the shown device. As to claims 15 and 16, Eisner also teaches disinfecting the cover after removal and placing it in a container, column 9, lines 53-60. Placing medical disposal material for burning is well known in the art and would be obvious to the skilled artisan in order to safely dispose of the material.

***Allowable Subject Matter***

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3732

***Remarks***

It is noted that applicant filed an RCE continued examination application in this case, however, no amendment has been received. As such, this rejection is the same as the final rejection of Paper No. 21 and this rejection is properly made final. If applicant filed an amendment before the mailing of this action, a request to have the final withdrawn should be submitted with a copy of the amendment and a copy of a receipt from the PTO showing the date the paper was received.

***Conclusion***

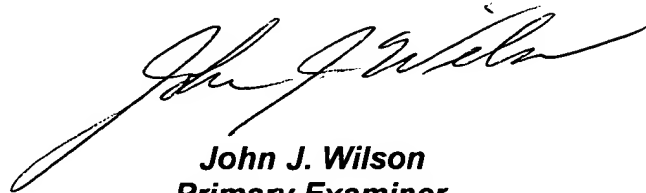
This is a continuation in the form of an RCE of applicant's application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 3732

the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to John Wilson at telephone number (703) 308-2699.

A handwritten signature in black ink, appearing to read "John J. Wilson", with a long, sweeping underline.

**John J. Wilson**  
**Primary Examiner**  
**Art Unit 3732**

jjw

March 10, 2004

Fax (703) 872-9306

Work Schedule: Monday through Friday, Flex Time